REMARKS

Summary

Claims 1, 2, 4, 5, 8-11, 13-16, 18, 22-24, 49-57, and 60-66 stand in this application. Claims 25-48 remain withdrawn. Applicant herein amends claims 1, 2, 4, 5, 11, 13, 15, 16, 18, 57, and 60-62 and cancels claims 3, 6, 7, 12, 17, 19-21, 58, and 59. Applicant herein adds new claims 67-83. Applicant respectfully asserts that all standing claims are patentable and solicits a timely Notice of Allowance for the same.

Withdrawn Claims

Applicant points out that the Office Action Summary on line 4a incorrectly fails to acknowledge claims 25-48 as being withdrawn from consideration.

Claim Objections

The Examiner objected to claims 4 and 17 as containing informalities. Applicant has amended claim 4 as the Examiner suggested and has canceled claim 17.

Claim Rejection under §112, First Paragraph

The Examiner rejected claims 49-51 and 63-66 alleging that the specification does not reasonably provide enablement for determining a location of the item relative to the data reader and correlating the location of the tag sensing operation for use in analyzing system operation. Applicant respectfully disagrees.

M.P.E.P. §2164 recites that "[d]etailed procedures for making and using the invention may not be necessary if the description of the invention itself is sufficient to permit those skilled in the art to make and use the invention." More specifically, M.P.E.P. §2164.01 recites that "the test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation" (citing United States v. Teletronics, Inc., 857 F.2d 778, 785, 8 U.S.P.Q.2d (BNA) 1217, 1223 (Fed. Cir. 1988)). "In order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention." M.P.E.P. §2164.04 (citing In re Wright, 999 F.2d 1557, 1562, 27 U.S.P.Q.2d (BNA) 1510, 1513 (Fed. Cir. 1993)).

"To overcome a prima facie case of lack of enablement, applicant must demonstrate by argument and/or evidence that the disclosure, as filed, would have enabled the claimed invention for one skilled in the art at the time of filing." M.P.E.P. §2164.05 (emphasis in original). At least paragraphs [00122] though [00125] disclose multi-sensor and multi-plane units and how each may be used to locate a label (e.g., a barcode or RFID) relative to the data reader by determining which plane, sensor, or the like first detected the label. For example:

> . . . where the RFID transmitter/receiver or the EAS sensor/deactivator is a multi-sensor or multi-plane unit . . . the sensing system may acquire information as to which sensor/antenna (of a multi-sensor unit) was the sensor which first detected the tag, or the order of detection as between multiple sensors, namely upstream sensor or downstream sensor; vertical sensor or horizontal sensor.

Further, for an embodiment including a multi-plane scanner, paragraph [00123] recites that ". . . knowing either the window or the scan line (or both), the system may deduce the position/orientation of the item from the position/orientation of the barcode being read."

Paragraph [00123] further recites that "[p]resuming that the tag is positioned proximate the barcode label, the system may provide correlation data as to the position of the EAS tag during the scan-sense-deactivate process. . . ." Accordingly, in an embodiment, to know the location of the label is to know the location of the EAS tag. Applicant asserts that the label location on a given item would also be something of which one skilled in the art would be aware. For example, items generally have consistent label locations (e.g., on the bottom or on the back of the item or item package). Further, before multi-line and/or multi-sensor data reader systems, and particularly with respect to barcode scanners, a checkout employee would learn the consistent barcode placement on items to increase their scanning efficiency. Applicant therefore asserts that undue experimentation would not be required to identify and accumulate label placement information for each item. As such, Applicant respectfully asserts that the specification enables determining a location of the item relative to the data reader when the label is read and correlating the location of the item to the electronic tag sensing operation for use in analyzing system operation as recited by independent claim 49. Accordingly, Applicant respectfully affirms that they have overcome the Examiner's rejection of claims 49-51 and 63-66.

Claim Rejections under §103

Claims 1-3, 6, 11-16, and 18

The Examiner rejected claims 1-3, 6, 11-16, and 18 as being unpatentable over United States Patent Application Publication US 2003/0075602 to Wike Jr. et al. (herein Wike) in view of United States Patent Number 6,025,780 to Bowers et al. (herein Bowers). Applicant

respectfully traverses the rejection, and requests that the Examiner reconsider and withdraw the obviousness rejection.

The Office Action has failed to meet its burden of establishing a prima facie case of obviousness. According to M.P.E.P. §2143, three basic criteria must be met to establish a prima facie case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. (See also M.P.E.P. §706.02(j) citing In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d (BNA) 1438 (Fed. Cir. 1991)).

As recited above, to establish a prima facie case of obviousness under §103 the cited references, when combined, must teach or suggest every element of the claim. (See M.P.E.P. §2143.03). Applicant respectfully submits that the Office Action has not established a prima facie case of obviousness because the cited references, taken alone or in combination, fail to teach or suggest every element recited in currently amended independent claims 1 and 11. Therefore currently amended independent claims 1 and 11 define over Wike in view of Bowers whether taken alone or in combination.

For example, currently amended independent claim 1 recites in a salient portion:

> . . . assembling data of EAS system operation pertaining to sensing and attempting to deactivate the EAS tag including the number of deactivation attempts;

correlating the EAS system operation data including the number of deactivation attempts to the item identified.

Currently amended independent claim 11 recites a similar limitation. Applicant agrees with the Examiner that Wike is silent as to assembling data of EAS system operation pertaining to sensing and attempting to deactivate the EAS tag and correlating the EAS system operation to the item identified. The Examiner asserts that Bowers FIG. 4 teaches the same. Applicant respectfully disagrees for at least two reasons. First, Bowers column 6 lines 30-34 recite that "[e]ach numbered record in the database 200 includes a field for tag information 202 comprising tag identification information 204 and variable information in the form of one or more status bits 206." Bowers column 6 lines 35-37 further indicate that ". . . there may be additional fields for other information 208 pertaining to the record, such as article status 210 and article identification 212." According to Bowers, the deactivation of the tag (electronically, physically, or virtually) alters the status bits, whether stored in the tag or in the database.

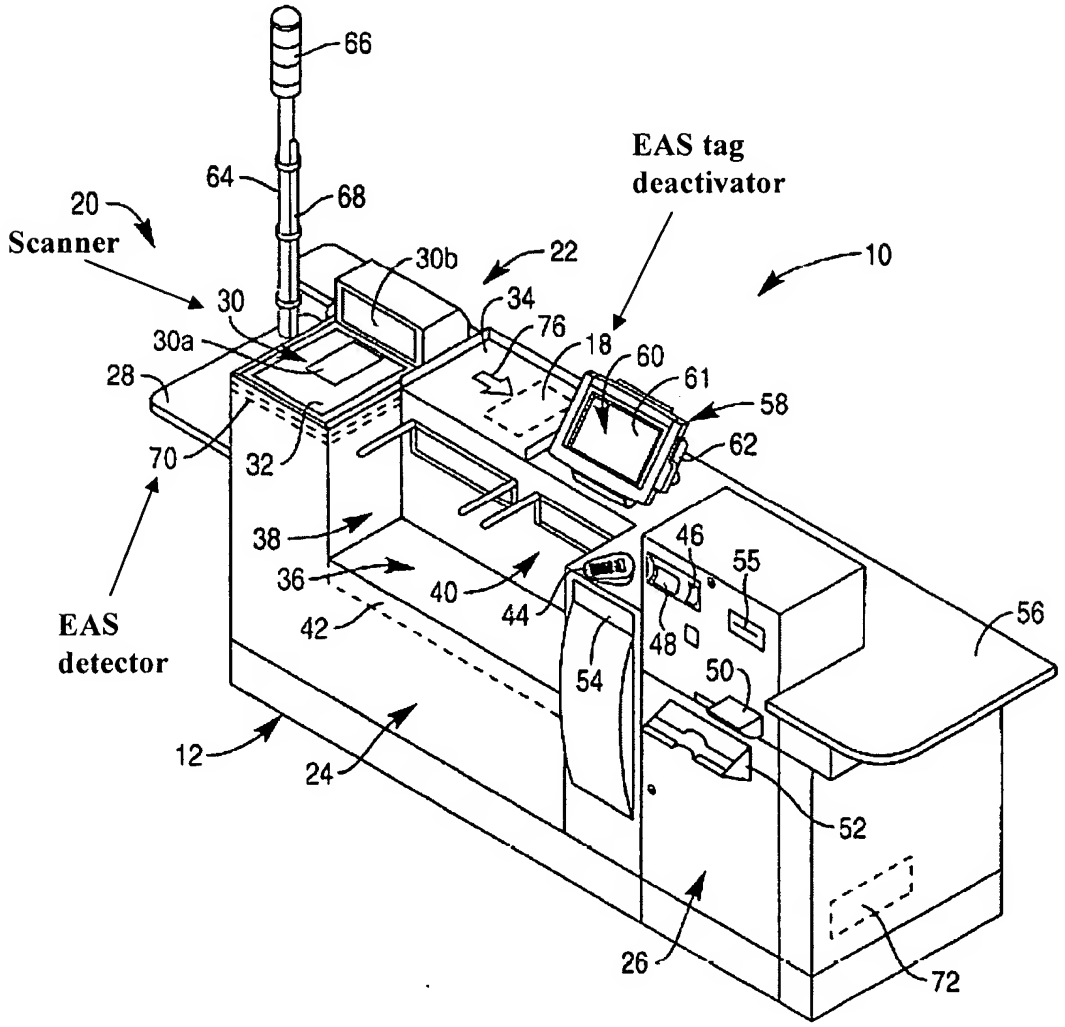
However, the status bits associated with the tag identification information reflect only the **current status** of the tag (e.g., whether or not the tag is currently deactivated). This is consistent with the purpose of Bowers to use electronic tags in a security system. For instance, Bowers discussed exit interrogation/ tag interrogation to determine whether or not a tagged item should be permitted to leave the store (See Bowers Abstract and FIGS. 9-10). Applicant's claim 1, while related to a security system, is directed to capturing EAS tag system **performance data**, not stopping a shoplifter or thief. That is why claim 1 calls for assembling data of EAS system operation pertaining to sensing and deactivating the EAS tag **including the number of deactivation attempts**.

Second, Applicant asserts that Bowers teaches recording **article status** in the status bits. For example, Bowers column 6 lines 50-55 recite that "[i]f the tagged articles are retail items, the article status 210 indicates whether the article is sold, unsold, returned, or resold" and that "[i]f the tagged articles are books, videotapes, or other types of articles which are borrowed and returned, the article status 210 indicates whether the article is checked in or checked out. . ." Further, the status bits directly reflect article status as ". . . the article status 210 is a human readable form of the status bit(s)." (See also "Electronic Deactivation," column 7 lines 18-34).

Applicant therefore asserts that the status bits according to Bowers only represent the **current article status** (e.g., sold, unsold, returned, resold, checked in, or checked out) and not number of deactivation attempts as recited by independent claims 1 and 11. Accordingly, Applicant affirms that currently amended independent claims 1 and 11 are patentable as each recites at least an element not taught by Wike and Bowers either alone or in combination. Dependent claims 2, 4, 5, 8-10, and 13-16, and 18 are also patentable as each depends from a patentable independent claim.

Additionally, with respect to canceled claim 6, at least a portion of which has been included in currently amended independent claims 1 and 11, the Examiner alleges that Wike teaches that after a predetermined number of deactivation attempts that help can be provided. The Examiner further opined that as a result, Wike teaches recording the number of deactivation attempts, as the number is stored / logged, even if temporarily, in order to determine when the condition is met. Applicant disagrees, however, that Wike teaches correlating the EAS system operation data including the number of deactivation attempts to the item identified as recited by currently amended independent claims 1 and 11.

For example, Wike FIG. 2, included below, illustrates that the scanner 30 and EAS detector 70 are located separately from EAS tag deactivator 18.



More specifically, Wike paragraph [0043] recites that ". . . an EAS detector 70 is provided proximate the scanner 30. . ." and that the EAS detector is ". . . operative to monitor, sense or detect an EAS tag on an item that is being scanned." However, Wike paragraph [0045] recites that "[t]he itemization area 22 also includes a post-scanning or set-aside area or shelf 34. . ." and

that "[a]n EAS or security deactivation area, device or deactivator 18 is provided at the set-aside shelf 34." **Applicant asserts that Wike does not teach that deactivating an EAS tag may be linked to or associated with the product identification**. For example, an item that has been scanned may thereafter be deactivated, but at least without being scanned again for both identification and EAS tag detection, EAS tag deactivation data may not be collected and associated with the item identification. Accordingly, Applicant respectively affirms that currently amended independent claims 1 and 11 are patentable as Wike and Bowers, either alone or in combination, fail to teach assembling data of EAS system operation pertaining to sensing and deactivating the EAS tag including the number of deactivation attempts and correlating the EAS system operation data including the number of deactivation attempts to the item identified. Accordingly, Applicant again affirms that currently amended independent claims 1 and 11 are patentable as each recites at least an element not taught by Wike and Bowers either alone or in combination. Dependent claims 2, 4, 5, 8-10, and 13-16, and 18 are also patentable as each depends from a patentable independent claim.

Claims 4 and 17

The Examiner rejected claims 4 and 17 as being unpatentable over Wike in view of Bowers and in further view of United States Patent Number 6,281,769 to Canipe et al. (herein Canipe). Applicant reaffirms that claim 4 is patentable as it depends from a patentable independent claims as discussed above. Applicant herein cancels claim 17 and will respond to the rejection with reference to claim 16 that has been amended herein to include at least an

element of claim 17. Applicant contends that claims 4 and 16 are further patentable as each contains at least an element not taught by Wike in view of Bowers and Canipe.

In particular, the Examiner alleges that Canipe teaches ". . . that separate signals are generated and that after reading an item, the EAS deactivator remains activated for a predetermined amount of time." The Canipe Abstract indicates that "[t]he sensor output signal triggers the EAS tag deactivator, which will remain energized for a preselectable period of time to deactivate an EAS tag associated with the article." Further, Canipe column 3 lines 32-36 recite that "EAS tag deactivator 18 will turn off after the preselected period of time has expired to reduce power consumption and use, and to prevent deactivation of EAS tags 24 when no indicia 23 has been read by POS reader 6." **Applicant asserts that Canipe merely teaches the activation of an EAS deactivator for a limited time based on a trigger from a POS reader**. Canipe does not teach any communication from the EAS deactivator thereafter (e.g., to the POS reader) to link or match EAS deactivation to the trigger from the POS reader. Applicant affirms that claims 4 and 16 are patentable over Wike, Bowers, and Canipe as they individually and in combination fail to teach matching the EAS system operation data to the identification data if the EAS system operation data is received by the host within a predetermined time period of receiving the identification data. Accordingly, in addition to being patentable as depending on patentable independent claims, Applicant affirms that claims 4 and 16 are patentable as each recites at least an element not taught by Wike in view of Bowers and Canipe.

Claims 5 and 18

The Examiner rejected claims 5 and 18 as being unpatentable over Wike in view of Bowers and in further view of United States Patent Number 5,837,983 to Actis et al. (herein Actis). Applicant reaffirms that claims 5 and 18 are patentable as each depends from a patentable independent claim as discussed above. Applicant contends that claims 5 and 18 are further patentable as each contains at least an element not taught by Wike in view of Bowers and Actis.

Currently amended claim 5 recites in a salient portion:

> . . . wherein the step of collecting data comprises measuring a time it takes to sense the EAS tag after reading the label.

Currently amended claim 18 recites a similar limitation. The Examiner alleges that Actis teaches a monitoring system for optical codes including an average read time field 717. Actis column 6 line 61 bridging column 7 line 2 recite that ". . . the readability measuring function block 154 measures and stores . . . the time needed to read the symbol (which is generally proportional to the number of scans needed to read the label for a reader with a fixed scan rate)." Applicant asserts that the time to which the cited portions of Actis refer is the time elapsed between detecting an item and reading the symbol. Actis does not therefore teach measuring a time it takes to sense the EAS tag **after** reading the label as recited by currently amended claims 5 and 18. Accordingly, in addition to being patentable as depending on patentable independent claims, Applicant affirms that claims 5 and 18 are patentable as each recites at least an element not taught by Wike in view of Bowers and Actis.

Claims 7-10 and 22-24

The Examiner rejected claims 7-10 and 22-24 as being unpatentable over Wike in view of Bowers and in further view of United States Patent Application Publication US 2003/0234288 to Canipe et al. (herein Canipe). Applicant herein cancels claim 7. Applicant reaffirms that claims 8-10 are patentable as each depends from a patentable independent claims as discussed above. Applicant contends that claims 8-10 and 22-24 are further patentable as each contains at least an element not taught by Wike in view of Bowers and Canipe.

Independent claim 22 recites in a salient portion:

> . . . means within the combined system for identifying a defective EAS tag;
> means for indicating presence of the defective EAS tag;
> means within the combined system for tallying a number of defective EAS tags by type of item identified.

The Examiner alleges that Canipe teaches logging transactions for which EAS tag deactivation did not occur in an attempt to mitigate problems. For example, Canipe paragraph [0042] recites that ". . . a system consistent with the invention may be used to facilitate data-logging associated with the failed deactivation of an EAS tag at a fixed POS location." Further, paragraph [0047] recites that "[a] review of the transaction log . . . may provide an early indication of a manufacturer's error in placement of an EAS tag in the article packaging, a malfunction of a fixed POS station 104, 106, an operator error at a POS station, etc.." **Applicant respectfully asserts that Canipe teaches only defective EAS tag placement and defective POS station operation. Canipe does not teach a defective EAS tag.** For that reason, Canipe cannot teach means within the combined system for identifying a defective EAS tag, means for indicating presence of the defective EAS tag, nor means within the combined system for tallying a number

of defective EAS tags by type of item identified as recited by independent claim 22. Canipe further fails to teach identifying a defective EAS tag, tallying the number of defective EAS tags by type of item identified, nor determining EAS tag quality as recited by claims 8-10 respectively. Accordingly, Applicant Affirms that independent claim 22 is patentable as it recites at least an element not taught by Wike, Bowers, and Canipe either alone or in combination. Claims 23 and 24 are patentable as each depends from a patentable independent claim. Further, in addition to being patentable as depending on patentable independent claims, Applicant affirms that claims 8-10 are patentable as each recites at least an element not taught by Wike, Bowers, and Canipe either alone or in combination.

Claim 52

The Examiner rejected claim 52 as being unpatentable over Wike in view of United States Patent Application Publication US 2002/0038267 to Can et al. (herein Can). Applicant respectfully traverses the rejection, and requests that the Examiner reconsider and withdraw the obviousness rejection.

Independent claim 52 recites in a salient portion:

> . . . detecting a manual activation of the EAS system to deactivate an EAS tag; and
>
> storing an indication of the detected manual activation of the EAS system.

The Examiner alleges that Can paragraphs [0027] and [0090] teach that RFID tags are useful in preventing employee theft because it is possible to maintain records of the identity of a person deactivating or flagging the RFID tag. For example, paragraph [0090] recites that "RFID technology offers the advantage of being able to store the identity of the person deactivating or

flagging the tag." Applicant asserts that Can may teach detecting the person who deactivated the RFID tag, but does not teach monitoring the deactivator itself (e.g., activation of the deactivator). Can therefore does not teach detecting a manual activation of the EAS system to deactivate an EAS tag as recited by independent claim 52. Accordingly, independent claim 52 is patentable as it recites at least an element not taught by Wike and Can either alone or in combination. Claims 53-56 are patentable as each depends from a patentable independent claim.

Claims 53-56

The Examiner rejected claims 53-56 as being unpatentable over Wike in view Can and in further view of United States Patent Number 6,795,809 to O'Brien. Applicant reaffirms that claims 53-56 are patentable as each depends from a patentable independent claim as discussed above. Applicant contends that claims 53-56 are further patentable as each contains at least an element not taught by Wike in view of Can and O'Brien.

For example, the Examiner alleges that O'Brien teaches cashier tests for logging events for security. Specifically, O'Brien column 12 lines 62-67 illustrate that the cashier test ". . . can be used to monitor security situations, such as voided transactions, over-rings, and manager overrides." Further, the cashier test ". . . can also be used to collect data on operator performance or used to feed data to a time and attendance system." **Applicant respectfully asserts that the cited portions of O'Brien fail to disclose that the cashier test includes any information with respect to an EAS system or the activation thereof.** As such, in addition to being patentable as depending from a patentable independent claim, Applicant affirms that claims 53-56 are

patentable as each recites at least an element not taught by Wike, Can, and O'Brien either alone or in combination.

Claims 57-58

The Examiner rejected claims 57-58 as being unpatentable over Wike in view Can and in further view of Bowers. Applicant respectfully traverses the rejection, and requests that the Examiner reconsider and withdraw the obviousness rejection.

Currently amended independent claim 57 recites in a salient portion:

> . . . if the deactivation attempt was successful, transmitting an indication of the manual deactivation to the POS terminal or host system, the indication of the manual deactivation including a predetermined optical code.

Applicant herein cancels claim 58. With respect to claim 59, a portion of which has been included in currently amended independent claim 57, the Examiner notes that Wike, Can, and Bowers are silent to transmitting a predetermined optical code to the POS terminal or host system. Applicant agrees. Accordingly, Applicant affirms that claims 57-58 are patentable as each recites at least an element not taught by Wike, Can, and Bowers either alone or in combination.

Claims 59-60

The Examiner rejected claims 59-60 as being unpatentable over Wike in view Can and Bowers and in further view of United States Patent Number 6,497,361 to Mason. Applicant traverses the rejection.

Applicant herein cancels claim 59 and will respond to the rejection with reference to independent claim 57 that has been amended herein to include at least a portion of claim 59 as recited above. The Examiner alleges that Mason teaches that a predetermined optical code is read and sent to the POS / host as part of a security check prior to deactivation. For example, Mason column 3 lines 40-42 recite that ". . . the system performs a security check to determine whether the proper item has been scanned." Further, Mason column 3 lines 53-56 recite that ". . . a security check is provided to ensure that the correct item has been itemized, whether the item has been itemized by an input at the touch-screen display or by scanning of a bar code." Applicant asserts that Mason teaches scanning to identify the item **before** the EAS system is activated and is silent to any indication of the deactivation that occurs thereafter. Applicant affirms, therefore, that currently amended independent claim 57 is patentable as Wike, Can, Bowers, and Mason, either alone or in combination, fail to teach transmitting an indication of the manual deactivation to the POS terminal or host system, the indication of the manual deactivation including a predetermined optical code. Claim 60 is patentable as depending from a patentable independent claim.

Claims 57-60

The Examiner rejected claims 57-60 as being unpatentable over Wike in view Can and Bowers and in further view of United States Patent Number 6,592,037 to Clancy. Applicant traverses the rejection.

The Examiner alleges that while Wike, Can, and Bowers are silent to transmitting a predetermined optical code to the POS terminal or host system, Clancy teaches that certain

articles are coded to indicate that they include a security tag. For example, Clancy column 1 lines 36-40 teach a code including article information and that the article information ". . . contains an indication as to whether the article is protected against pilferage by an electronic security element, and by having a deactivation unit switched on when the presence of a corresponding indication is established." Clancy column 2 lines 31-35 recite that "[a]rticle information for each barcode is saved in this storage unit 7" and that the ". . . information includes, among other items, price information and an indication as to whether the article is protected against pilferage by an electronic security element." Applicant asserts that Clancy teaches activating an electronic security element deactivator depending on whether the article information indicates that the article includes such a security element. **Clancy fails to teach however any processes following the activation of the electronic security element deactivator.** Applicant therefore affirms that Clancy cannot teach transmitting an indication of the manual deactivation to the POS terminal or host system, the indication of the manual deactivation including a predetermined optical code as recited by currently amended independent claim 57. Accordingly, Applicant asserts that currently amended independent claim 57 is patentable as it recites at least an element not taught by Wike, Can, Bowers, and Clancy, either alone or in combination. Claims 60-62 are patentable as each depends from a patentable independent claim.

Claims 61-62

The Examiner rejected claims 61-62 as being unpatentable over Wike in view Can, Bowers, and Mason in further view of O'Brien. Applicant reasserts that claims 61 and 62 are patentable as each depends from a patentable independent claim.

Claim Rejection under §102

The Examiner rejected claim 19 as being anticipated by Wike. Applicant herein cancels claims 19-21.

CONCLUSION

For at least the foregoing reasons, Applicant submits that they have overcome the Examiner's rejections and that they have the right to claim the invention as set forth in claims 1-1, 2, 4, 5, 8-11, 13-16, 18, 22-24, 49-57, and 60-83. Accordingly, Applicant earnestly solicits a timely Notice of Allowance to this effect. The Examiner is invited to contact the undersigned at 503-294-9678 to discuss any matter concerning this application.

Respectfully submitted,

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